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| 09/277,189 | 03/26/1999 | EDWARD G. MCLAUGHLIN | 7196-RCE | 3185 |

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| EXAMINER |
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POINVIL, FRANTZY

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| ART UNIT | PAPER NUMBER |
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3691

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPAdmin@reinhardtllaw.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/277,189 | Applicant(s) MCLAUGHLIN ET AL. | |
| | Examiner Frantzy Poinvil | Art Unit 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 31-53 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (US Patent No. 5,963,925) in view of Lech et al (US Patent No. 6,094,505).

As per claims 31, 38, 39 and 46 and 53, Kolling et al disclose a system and method for providing electronic statements to clients of a financial institution or service provider. Kolling et al state:

" An electronic statement presentment (ESP) system replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery. Electronic statements have the same look as paper statements as well as including video, audio, graphics, and custom enclosures. Statements are segmented into mandatory and optional components to minimize download time. The ESP system operates independently or is an enhancement to any

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suitable electronic bill payment system". See the abstract. The presentment system of Kolling et al is similar to the claimed location for the customer.

. Kolling et al does not explicitly recite the manner in which the paper bills were transformed or scanned into electronic bills or documents.

Kolling et al then state:

"The present invention is able to receive all electronic statements from a particular biller during a given billing cycle (for those customers that wish electronic statements) and then distribute those electronic statements to the appropriate consumer financial institutions for later delivery to the customers. Customers of a particular biller may use a variety of consumer financial institutions. Routing of the statements to the correct institution for eventual delivery to the customer is performed by the electronic statement presentment system. The task of contacting the consumer and providing the electronic statement in an appropriate medium is left to the consumer financial institution".

This passage also give hints that Kolling et al may obtain both electronic and paper bills so as to transmit these bills in an electronic form to a bank, financial institution or consumer of a service provider. Furthermore, it should be noted that Kolling et al does not positively state that they do not obtain paper bills or they cannot have paper bills using a mailing system. Also, nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. A biller in the system of Kolling may not have the capability to electronically transmit electronic bills to the system of Kolling for further processing by Kolling. Thus, transmitting

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paper bills to the system of Kolling would have been readily acceptable through the regular mail system. In so doing, the well known method of scanning paper documents or paper bills would have implemented by Kolling et al. Alternately, One of ordinary skill in the art would have turned to Lech et al for the provision of this teaching.

Lech et al disclose a system, method and computer program product for converting a paper bill into an electronic bill for consumer viewing. See the abstract of Lech et al. Lech et al state:

“An information processing methodology gives rise to an application program interface which includes an automated digitizing unit, such as a scanner, which inputs information from a diversity of hard copy documents and stores information from the hard copy documents into a memory as stored document information. Portions of the stored document information are selected in accordance with content instructions which designate portions of the stored document information required by a particular application program. The selected stored document information is then placed into the transmission format required by a particular application program in accordance with transmission format instructions. After the information has been transmission formatted, the information is transmitted to the application program. “. See the abstract of Lech et al.

The claimed limitation of a "zone information for locating portions of the billing information" is also taught by Lech et al on column 6, line 66 to column 7, line 19 and column 10, lines 30-65 of Lech et al. Thus, the limitations of “identifying a type of the scanned paper bill; extracting billing information from the electronic image information using a predefined template corresponding to the identified bill type, wherein the predefined template includes zone information for locating portions of the billing information are clearly taught or

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suggested by Lech et al. Comparing the extracted billing information with known information (comparison may be done by a user who scanned the document or by the computer system or by a comparison with scored document module 2.1.1 or correct errors module 2.1.2 of Lech et al.). See column 8, lines 35-43 of Lech et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lech et al into the system and method of Kolling et al in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer. The motivation would have been to encourage billers who are not yet ready to transmit electronic bills to the bill processors of Kolling to do so, and also to facilitate the processing and/or conversion of paper bills to electronic bills format for better, faster and more accurate purpose. The electronic bills are sent or presented to the consumers for viewing or making payments or for reviewing purposes..

As per claims 32 and 42, removing unnecessary material from the received paper bill is taught by Lech et al at column 8, lines 35-43 as Lech et al teach error-correction techniques. Kolling further teaches forwarding important documents from the received bills to the customer (see the abstract and column 4, lines 15-29); receiving a payment instruction from the customer to pay a bill, drafting a payment on an account for the customer account, and sending the payment to the biller that originated the bill (are taught on column 9, lines 13-28 of Kolling).

As per claims 33, 41 and 48, the combination of Kolling and Lech et al does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Lech et al would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claims 34 and 49, Kolling et al state:

“In step 830 SGEN 222 sends this build message to the appropriate CSP based upon the CSP identifier. In step 832, once the CSP has received a message containing an electronic statement for a particular consumer, it delivers this electronic statement to the consumer using any suitable medium that it has arranged for communication to the consumer. Once the CSP has verified that the consumer has received or accessed the electronic statement, the CSP sends a delivery notification message back to the biller. Thus, during a billing cycle a biller is able to present electronic statements to those consumers wishing to receive them. Advantageously, those consumers also wishing to participate in an electronic bill payment system may then easily submit their payment along with remittance data to there CSP who forwards the payment and remittance data on to the biller.

FIG. 16 is a sample make payment screen 930 that is displayed when the customer clicks on the return button in band 884 from any of the previous three screens, or when the customer clicks on pay invoice button 878 of FIG. 12. Make payment screen 930 includes button s 932 for viewing accounts, payments, payees, or for logging off or receiving help. Also included is biller

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name 934, an amount due 936, a running balance 938, and a due date 940. The customer selects a payment amount 942, a payment date 944, a method of payment 946 and finally clicks pay button 948 to submit the payment via an electronic bill payment system for delivery back to the biller. A confirmation screen would typically follow such a transaction. A confirmation screen includes an acknowledgment of payment, and a listing of the payment method, date of payment, amount of payment and a confirmation number. Advantageously, the electronic invoice delivered to the customer from the biller contains all necessary information to construct an electronic bill payment transaction. This electronic remittance coupon information ensures the accurate and economical processing of the payment at the biller's account receivable operation“.

As per claims 35-36, 47 and 50-51, Kolling et al teach drafting a payment comprises the submitting an electronic payment wherein the step of submitting an electronic payment using one of an automated clearing house network, an automated teller machine network, and a credit card network. See column 9, lines 14-48 of Kolling et al. See also figures 3 and figure 8 of Kolling et al. Kolling et al further state:

“As mentioned above, FIG. 3 includes elements of an electronic bill payment system. To make a payment after receiving an electronic statement 224, consumer 140 makes a payment 230 to his or her CFI 130. CFI 130 then transmits payment information 232 (including a biller identification, a customer biller account number (CBAN), amount, date, etc.) to originating workstation (OWS) 234. OWS 234 transmits payment information 236 in modified form to switch 214 that routes payment information 236 to biller bank workstation (BBWS) 238.

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Payment information 236 is then transmitted to biller 102 where the payment information is reconciled with the biller's accounts receivable database”.

As per claim 40, Kolling et al disclose a biller identifier for identifying a particular bill or biller. See column 10, lines 48-65 and column 9, lines 40-45 of Kolling et al.

Claim 43 recites limitations contained in claim 31 and these limitations are addressed under a similar rationale. In regard to a payment instruction, a paper check and a printing of a remittance stub. See the rejection of claims 32-36 above.

As per claims 37, 44, 45 and 52, Lech et al discloses the extracting function as Lech et al state:

“The process document module 2.3 includes an extract data module 2.3.1. This module extracts data off of the document in accordance with the user's instructions, for example, the user-defined template, or through the interactive mode.

The process document module 2.3 also includes a preapplication process module 2.3.2 which gathers and associates information extracted from the document in accordance with content instructions. This module prompts the user for any additional information required to satisfy the relationships defined by the content instructions. The preapplication process module 2.3.2 also places the selected information into the transmission format defined by the transmission format instructions.

The preapplication process module 2.3.2 also generates the input file 2.3.3 for the selected application in accordance with the appropriate instructions. The input file 2.3.3 is then transmitted to bus 240 and/or communication interface 4.0 for transmission to a particular application unit 270. ” See also column 6, line 66 to column 7, line 19 and figure 8 of Lech et al. The motivation to include an extracting is given above and also to insure that specific information is always obtained from a particular paper bill.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3691

/FP/
January 13, 2011